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EXAMINER

TUPPER, ROBERT S

ART UNIT PAPER NUMBER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 20

Application Number: 09/892,790  
Filing Date: June 28, 2001  
Appellant(s): PARK ET AL.

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R. E. Bushnell  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/9/02.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The third amendment after final has been entered for this appeal.

**(5) *Summary of Invention***

The summary of invention contained in the brief is deficient because it fails to mention the first and second front projections defining air bearing surfaces (110a) and (110b), and the fourth projection (180) at the rear mounting the transducer.

**(6) *Issues***

The appellant's statement of the issues in the brief is not correct.

There are only two issues – (A) whether the newly presented claims are barred by impermissible recapture, and (B) whether the 102(a) art rejection is proper.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 21-60 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

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The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,568,981

NEPELA et al

10-1996

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-60 rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The following limitations have been omitted from ALL of the newly presented independent claims: "arcuate front wall", "first and second side wall portions for defining third and fourth air bearing surfaces", and four separate air bearing surfaces.

In the amendment of 12/01/98 in the parent application, Applicant specifically argued (see remarks on pages 11-12) the following structural features to define over the

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102 rejection based upon CHAPIN et al (5,200,868): (A) an arcuate front wall (page 11 line 16 and 21), (B) side wall portions defining third and fourth air bearing surfaces (page 11 lines 17-18 and 22), and (C) four separate air bearing surfaces (page 12 lines 7-9).

Claims 21, 30-32, and 41 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by NEPELA et al (5,568,981).

Note figure 5c. NEPELA et al shows a negative pressure slider with a U-shaped air bearing platform (108) defining a negative pressure cavity (not numbered – the area between the two rear extending legs of the U), the U-shaped air bearing platform having a cross rail portion (not numbered) and not more than two separate air bearing platforms (not numbered - the rear extending legs) which terminate before the rear edge of the slider, the not more than two separate air bearing platforms have side wall portions (not numbered), and a centered rear air bearing platform (120) which mounts a transducer.

The 112 rejections are hereby withdrawn.

**(11) Response to Argument**

Concerning the "recapture" rejection, Applicant appears to be arguing that the rejection is not proper because the claims in the parent application were not narrowed in response to the rejection in the first Office Action in the parent application.

This is not determinative. It is the Examiner's position that, in the parent application, Applicant specifically identified several structural features recited in the

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claims to define over the art rejection made against the originally filed claims in the parent application.

See Attachment A – in the remarks section (pages 11-12) of the amendment of 12/01/98 in the parent application, Applicant specifically argued that the following structural features defined over the art cited in the 102 rejection of the originally filed claims in the parent: (A) an arcuate front wall (page 11 lines 16 and 21), (B) side wall portions defining third and fourth air bearing surfaces (page 11 lines 17-18 and 22), and (C) four separate air bearing surfaces (page 12 lines 7-9).

ALL of the newly added claims in this reissue application omit these specific features.

Even assuming that the amendments made in the parent application after the first Office Action did not narrow the scope of the claims, the newly presented claims in this application are barred by surrender because of the specific arguments made by Applicant citing specific structural features to define over the art used to reject the originally filed claims in the parent application. Note *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998).

Concerning the 102 rejection, Applicant seems to have ignored cited figure 5c of NEPELA et al. This figure clearly shows a negative pressure slider with U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (the area between the legs of the U) with not more than two separate air bearing platforms (the leg portions).

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Applicant's references to the side rails (112,114) are not on point. These claims do not preclude the presence of other air bearing surfaces in addition to the U-shaped platform. Note also that these claims do not define the size or extent of the negative pressure cavity.

The slider shown in figure 5c has ALL of the structural features recited in these claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner  
Art Unit 2652



rst

February 21, 2003

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# ATTACHMENT (A) - APPLICANT'S ARGUMENT

SISA.031

Statement filed on August 28, 1998. Applicants also submit herewith "Proposed Drawing Revisions." Reexamination and reconsideration of the present application are also requested. Applicants acknowledge the Examiner's statement that claims 11-13 and 15-19 would be allowable if rewritten in independent form, including all limitations of base and intervening claims.

Applicants have submitted herewith Amendments to the specification and the claims. Applicants respectfully submit that no new matter has been added. Applicants have canceled claims 4-6, 8 and 20 and added new claims 21-25. Applicants have also amended claims 1-3, 7, 9-19. Accordingly, claims 1-3, 7, 9-19, and 21-25 remain pending in the application.

## 35 U.S.C. § 102 Rejections

The Examiner rejected original claims 1-3, 7, 9, 10 and 14 as anticipated by Chapin et al., noting the embodiment of Fig. 3j. Applicants respectfully traverse these rejections for at least the following reasons.

Claims 1-3, 7, 9-19, and 21-25 are drawn to a negative pressure air bearing slider which includes "*a U-shaped projection . . . including an arcuate front wall . . . for defining a negative pressure cavity therein.*" The U-shaped projection also has first and second side wall portions "*for defining third and fourth air bearing surfaces.*" Applicant respectfully submits that the claimed slider is not disclosed anywhere in Chapin. For example, Figure 3j cited by the Examiner shows a slider which clearly has neither a U-shaped projection with *an arcuate front wall portion for defining a negative pressure cavity*, nor does it have *third or fourth air bearing surfaces* spaced apart on the slider



body. Likewise, none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25.

Moreover, as can be clearly seen in Fig. 3j cited by the Examiner, Chapin's air bearing slider has the side rails 20 and 22 connected from leading edge to trailing edge without any broken sections. In contrast, in the air bearing slider according to the present claimed invention there are no side rails connected from leading edge to trailing edge. Instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are the four separate air bearing surface (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface. The two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket. This clearly distinguishes the slider of claims 1-3, 7, 9-19, and 21-25 of the present invention from Chapin.

Also, in Chapin's slider, the side rails 20 and 22 create the very narrow air channels 30 and 32 running from the front to the rear of the slider. Such narrow air channels are not produced in the present invention. Consequently, a difference between the Chapin and the present invention may be analogized to the difference between a river running through a plot of land (Chapin), and a lake with several islands located therein (the present invention).